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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,667	09/26/2001	Mark Thompson	020375-003500US	2848

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/29/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/965,667

Applicant(s)

THOMPSON, MARK

Examiner

JAGDISH N PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

*Claim Rejections - 35 USC §101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Claim 1 recites a method for managing a transaction for a sale of goods between a customer and a merchant. All limitations (method steps) of the claimed invention are broadly interpreted as being carried out manually without any technological means. This lack of technological implementation renders the claimed invention outside the framework of any technological art or environment (e.g. electronic commerce). (for further discussion of this subject please refer to *Ex Parte Bowman*, 61 USPQ2d 1669 (Unpublished)).

Dependent claims 2-12 inherit deficiency of the parent claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious<sup>2</sup> at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai (Pub. No.: US 2001/0037290) (hereafter Lai) and further in view of Sandhu et al. (US 2002/0116241) (hereafter Sandhu).

Claim 1: Lai discloses a method for managing a transaction for a sale of goods between a customer and a merchant (abstract), the method comprising:

Receiving by a provider..a communication relating to the transaction..(provider is a company agent, who receives the transaction information from the merchant, see para [0036]);

Collecting by the provider, the cost from the customer ..(escrow payment received from the customer, see para [0036]);

Paying, by the provider, the cost to the merchant after the merchant delivers the goods (the agent..then sends ..for transfer of payment.. see para [0037]).

Whereas, Lai teaches the claimed method substantially as recited, it however, fails to recite that the provider (agent having web site 12) is affiliated with a plurality of offices.

Sandhu, in the same field of endeavor, however, discloses a method for tracking and shipping goods from a seller to a buyer, wherein a provider (third party logistics suppliers, referred to as “3PL’s”) having a plurality of offices (para [0019] transportation and warehousing supplier) who keeps track of the purchase orders, shipping and inventory (para [0010].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Lai and Sandhu to have the escrow function and the logistics function of managing transaction and to provide a plurality of offices of the provider, because the combination would simplify the entire sales transaction process such that both the escrow function and the logistics functions are performed by a single entity. The combined method would provide anonymity of the customer, ensure satisfaction of the customer, ensure payment from the customer to the seller, and ensure that the customer receives the goods from the seller in a timely and efficient manner.

Claim 2: cost from the customer..cost of goods plus a service charge.. (Lai, inherent because the transaction process involves shipping the goods and it customary practice to add cost of goods in the transaction cost, para [0037]).

Claim 3: collecting a portion of the cost plus service charge ..and collecting reminder of the cost plus service charge ..(although not explicitly recited in the applied references, it is a obvious and customary practice in sales to provide for alternate payment arrangements by the merchants to the customers and therefore inherent in Lai reference).

Claim 4-5: customer and merchant are located in a different country (Lai provides for both the customers and the merchants (partners) have access of the

system via the Internet which reaches all users in the world, therefore this limitation is inherent, Fig. 1 and 2).

Claim 6: ..goods are delivered to by the merchant (Lai para [0037], shipping the goods from the designated merchant warehouse 148).

Claim 7: ..goods are delivered by the merchant to one of the ..plurality of offices..(Sandhu, para [0017], products shipped from the 3PL 18).

Claim 8-10: ..collecting cost from the customer..collecting at the one of the plurality of offices (refer to discussion of claim 1 wherein the agent collects the cost from the customer in escrow account, also refer to motivation for such combination). Claims 9-10 are similarly analyzed.

Claim 11: providing a hyperlink to a web site of the merchant (Fig. 10 block 125, also refer to para [0036] for relevant discussion].

Claim 12: Lai or Sandhu fails to teach that the provider arranges goods aggregately for shipment.

Official is notice is taken that aggregating goods for shipment is old and well known business practice. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement this process because aggregating goods (such as according to geographic address of the customer etc.) would reduce cost of shipment.

Claim 13 and 23 are analyzed as per corresponding method claim 1 which recite corresponding limitations.

Claim 14: refer to claim 5 analysis.

Claim 15: refer to claim 11 analysis.

Claim 16: refer to claim 3 analysis.

Claim 17: refer to claim 2 analysis.

Claim 18: refer to claims 7 and 8 analysis.

Claim 19: refer to claim 3 analysis.

Claims 20 and 21: Lai or Sandhu fails to teach service charge and currency exchange as recited.

Official is notice is taken that including shipping and insurance cost to the service charge and further performing currency transaction are old and well known business practices in sales and specifically in e-commerce transactions. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement these features as desired and needed by the merchant.

Claim 22: refer to claim 12 analysis.

Claim 24: refer to claim 5 analysis.

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***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687.

**Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.



Jagdish N. Patel  
(Examiner, AU 3624)

1/23/03